

REMARKS

Claims 20-25 are pending the application; Claims 20-25 stand rejected; Claims 21, 24 and 25 are objected to. Claim amendments has been made to address the informalities raised by the Examiner with respect to claims 21, 24 and 25. These amendments add no new matter to the application.

Claims 22 and 23 stand rejected under 35 USC 112 as allegedly not enabled. The applicant respectfully traverses this rejection. However, in the interests of expediting prosecution, the claims have been amended to delete the phrase “eliminating or preventing”.

Claims 21, 23 and 25 stand rejected under 35 USC 102 as allegedly anticipated by Womack. The applicant respectfully traverses this rejection. However, in the interests of expediting prosecution, claims 21 and 23 have been amended to read “*Uncaria*, species *tomentosa* and Ginko Biloba, in combination with...”. Applicant submits that Womack does not disclose a composition having the constituents of the amended claim and respectfully requests that the rejection be withdrawn.

Claims 20, 22 and 24 stand rejected under 35 USC 102 as allegedly anticipated by Hastings. The applicant respectfully traverses this rejection. However, in the interests of expediting prosecution, claims 20 and 22 have been amended to delete mention of Echinacea. Applicant submits that Hastings does not disclose a composition having the constituents of the amended claim and respectfully requests that the rejection be withdrawn.

Claims 21, 23 and 25 stand rejected under 35 USC 103 as allegedly obvious in view of Womack in combination with Hsia.

Applicant submits that the Examiner has not established a *prima facie* case of obviousness which is a requirement of section 2142 of MPEP. Specifically, the Examiner bears the burden of providing some suggestion of the desirability of doing what the inventor has done. In Ex Parte Clapp, 227 USPQ972, 973 (Bd. Pat. App. & Inter. 1985) it is stated,

“To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed

invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references” (our emphasis).

In section 2143.01 of MPEP it states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir, 1990).

Even if it is deemed that a *prima facie* case has been made, Applicant still traverses. Womack teaches a nutritional supplement system comprising Phase I and II supplements that enhance glucose metabolism and reduce or prevent the use of insulin for diabetics. Desirable aspects of his solution further relate to the convenience of administration, affordability and availability. Furthermore, although suggesting that the two nutritional supplements could be combined, Womack teaches away from this modification by indicating that individual alternate administration of the Phase I and II supplements avoids desensitization resulting in a longer term solution. Womack does not expressly or implicitly suggest the claimed invention nor is there expressed a desire to combine with other references to further enhance glucose metabolism as his system is carefully balanced to avoid desensitization.

Hsia teaches a holistic nutritional supplement that increases levels of HDL and calcium ions and decreases free radicals and glucose in plasma. Hsia states that the claimed compositions act on human systems to reduce risks of health problems and result in numerous benefits including decreasing glucose levels (column 3, line 63 to column 4, line 5). However, Hsia does not expressly or implicitly suggest the claimed invention nor is there expressed a desire that the supplements be further modified to result in the claimed invention.

Applicant submits that neither Womack nor Hsia either alone or in combination suggests the claimed invention, both are directed to reducing serum glucose levels. Both Womack and Hsia present independent solutions and do not suggest that further modifications are necessary or even desirable to their individual supplements. Furthermore no other art has been presented as evidence that the combination is desirable.

Claims 20, 22 and 24 stand rejected under 35 USC 103 as allegedly obvious in view of Hastings in combination with Hsia. Applicant submits that the Examiner has not established a *prima facie* case of obviousness for the same reasons as outlined above.

Hastings teaches a dietary supplement comprised primarily of protein enzymatically derived from collagen with other components and herbal additives that co-act with other components to promote healthy joint function. Hastings does not teach claimed invention nor does he teach that modifications of his supplement would result in a more efficacious supplement.

The Examiner has combined the teachings of Hsia with Hastings stating that the supplement of Hsia, in addition to decreasing glucose, is also of use in strengthening connective and joint tissue. The Examiner reasons that the skilled person would therefore be motivated to combine these teachings to achieve a better composition with joint enhancing effects. Applicant submits that such a combination only succeeds in diluting any motivation to combine Hsia with either reference as the skilled person must reasonably question which individual components of Hsia's composition would have efficacy for promoting joint health as opposed to efficacy for decreasing glucose concentration when combined with either Hasting or Womack for either given problem. Furthermore, Applicant submits that the skilled person without undue experimentation or direction from the prior art would not have a reasonable expectation of success.

As neither Hastings nor Hsia, either alone or in combination, suggests the claimed invention, nor do they suggest that further modifications are necessary or desirable to their individual supplements, and in view of the fact that no other art has been presented as evidence that such a combination would be desirable, Applicant respectfully asserts that a *prima facie* case of obviousness has not been established and requests that the obviousness objections be withdrawn.

Applicant believes that they have responded fully to all of the concerns expressed by the Examiner in the Office Action, and respectfully requests that early favorable action be taken on all claims pending in the application. Applicant respectfully requests reexamination of all

rejected claims and early favorable action on them as well. If the Examiner has any further concerns, Applicant requests a call to Patrick Dwyer at (206) 550-4049.

Respectfully submitted,



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